

No. 4582.

IN THE
United States
Circuit Court of Appeals,
FOR THE NINTH CIRCUIT. 4

David G. Lorraine, and The Lorraine
Corporation, a corporation,

Appellant.

vs.

Francis M. Townsend, Milon J. Trum-
ble and Alfred J. Gutzler, doing
business under the firm name of
Trumble Gas Trap Company,

Appellees.

APPELLANT'S REPLY BRIEF.

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The Only Questions on This Appeal Are:

Has Plaintiffs' Presumptively Valid Patent Been
Infringed?

Has the Presumption of the Validity of the Claims
in Suit Been Overcome?

There Is No Issue Arising or Growing Out of Prior
Litigation Between the Parties; Nor Is Any
Question as to the Construction of Defendants'
Trumble Patent Material Here.

The alleged history of the suit on the Trumble
Patent to which counsel, commencing on page 4 of ap-

pellees' opening brief has devoted so much attention does not aid in disposing of the case at bar. We disagree with the accuracy of the statement in many respects, and particularly with some of the inferences drawn therefrom, but shall not consume the time of the court in correcting what we believe will instantly be seen to be immaterial.

However, the court will notice the subtle attempt on the part of appellees (page 4, Appelles' Opening Brief) to transform the patent in suit into a mere improvement in valve mechanism: After stating at the top of page 4 of said brief that the patent in suit *refers* to improvements in gas, oil, and sand separators, near the bottom of the same page counsel implies that the patent is really on a valve mechanism. The fact is that two of the claims charged to be infringed, namely, 17 and 18 of the Lorraine Reissue Letters Patent in suit do not even mention a valve mechanism, and the remaining claim (19) only refers to a valve as a small part of a combination of elements such as the two chambers, float, etc. It is true that one of the valuable contributions to the art is the Lorraine synchronously operated valves, which combination is covered by claim, 3 for instance, of the Lorraine patent; but this claim is not charged to be infringed.

What difference does it make in the present proceedings which claims of the Trumble patent in prior litigation were charged to be infringed and what the court found with respect thereto,—except to show that defendants have a patent which has been sustained by

this court and which defendants could, if they saw fit, use without infringing upon the exclusive rights of Lorraine?

We solemnly assure the court that it is not true, as stated by counsel at page 6 of appellees' opening brief that the business of plaintiff "had its incipiency in the piracy of defendant-appellees' patent rights:" but for the sake of argument let us assume that the statement is true, and as further to be inferred from counsels' remarks that plaintiffs have paid the penalty for such wrong doing. * * * Shall defendant-appellees now be permitted to *maintain* their business by piracy on plaintiff-appellant's rights and *escape without paying the penalty*, or shall the court follow its usual practice by an earnest attempt to right the present wrong?

Counsel is presuming a great deal in the assertion (Appellees' Opening Brief, bottom p. 6) that the filing of the present suit for infringement was designed to have some mysterious effect on the Trumble trial and upon the trade. The fact is "the shoe was on the other foot": it was defendant-appellees in their advertisements who misrepresented the scope and effect of the injunction entered in compliance with this court's direction,—attempting to make it appear that Lorraine was prohibited from selling traps which were plainly non-infringements,— but these things are not in issue before this court in the present proceeding; their consideration only confuses the issue,—so why allow ourselves to be diverted from the *real* issues by them. Such subtle attempts to create prejudice should

not confuse the court. Again we urge that the issue is simply: *has our presumptively valid patent been infringed?*

While there is no doubt but that defendants feverishly examined the Lorraine patent immediately after its issue, and possibly were advised by their counsel that they did not infringe (as stated in Appellee's Opening Brief, p. 7) the original claims, and while such fact is not at all material here, nevertheless they were *prior* to that time actually copying the Lorraine trap and necessarily utilizing the subject-matter of the Reissue claims here in suit which were thereafter allowed.

It is not material whether or not, as counsel has stated on page 8 of appellees' opening brief, the Lorraine patent was limited to the valve mechanism. Nevertheless, it is *not* an admitted fact, as erroneously stated by counsel. It only requires a brief reference to the claims of the original Lorraine patent numbers 1 and 2, for instance, to show that such statement is in error.

A Flood of Blue Prints Does Not Under the Law Prove Prior Knowledge of a Device nor Does It Prove Prior Use (Even If Adequately Illustrating the Combination of Claims in Suit) Any More Than Numerous Plans to Commit a Murder Would Establish That the Crime Had Been Consummated.

If a Natural Person Instead of Our Patent Were on Trial for His Life How Carefully This Court Would Guard Against the Influence of Prejudice, the Unsupported Assertions of Counsel, and Findings, Express or Implied, Not Firmly Based Upon Unassailable Evidence. Clear, Definite, Unmistakable Proof to a Moral Certainty Would Undoubtedly Be Required by This Court to Sustain Any Such Conviction; for Enforcement of the Forfeiture of Human Life Is the Gravest of Judicial Responsibilities.
* * * and the Law Holds the Same Shield of Protection Over Our Patent.

That proof of invalidity of a patent should be to a moral certainty was decided by this Honorable Court (Judges Gilbert, Morrow and Wolverton) in San Francisco Cornice Co. v. Beyrle, 195 Fed. Rep., 516, and the rule has been applied in many other cases by Your Honors, one of the latest of which being Schumacher v. Buttonlath Mfg. Co., 292 Fed. Rep. 522.

That "beyond a reasonable doubt" means the same thing in a patent cause as it means in a murder trial was decided in Nicholas Power Company v. G. R. Baird Company, 222 Fed. Rep. 933 (bottom of p. 941).

As a single murder would justify infliction of the death penalty, so a single prior use would warrant a decree of invalidity of our patent. The presumption of validity in a patent cause being like the presumption of innocence in a criminal proceeding, this court has held (*Schumacher v. Buttonlath, supra*) that such most heavy burden of proof *is upon him who denies validity*. Under the circumstances, what the court should expect from the four most able patent counsel who sign defendant-appellees' opening brief, and from their client, Townsend, who is also a patent attorney (all exceedingly well versed in the laws of evidence in patent causes and particularly cognizant of the requirement of proof beyond a reasonable doubt to defeat a patent) is—not rolls of blueprints seemingly accompanied by the grandiloquent suggestion that there *may have been* almost too many prior uses to mention—not general assertions as, for instance, what the proofs “fully show” (Appellees' Opening Brief p. 7) or what is “demonstrated by the oral testimony (Appellees' Opening Brief p. 27)—not a mere wave of the hand in the direction of a number of witnesses with a study-the-record-diligently-and-you-may-dig-out-sufficient-support-for-our-assertions attitude. Such tactics on the part of the defense should not satisfy the court to a *moral certainty* that anticipation has been established.

We emphatically deny, for instance, that “no changes whatever have been made in the co-operative relations of the various elements of the Trumble trap” since the invention of the claims in suit, as asserted by

counsel (Appellees' Opening Brief, bottom p. 10). Why did counsel neglect to tell us who testified to such fact?

We deny the truth of counsel's statement (Appellees' Opening Brief, p. 27) that it is "demonstrated by oral evidence in the case" that the high oil level, *per se*, was the invention of the claims in suit. (We hereafter in this brief point out distinctly, positively, and unmistakably *why* this feature is not the invention.)

We also deny, as stated near the bottom of page 27, appellees' opening brief, that the early Trumble Traps were provided with means for regulating the oil level carried in the trap; and deny that "wide (or any substantial) range of adjustment was provided." (As we shall show, a blue print or drawing is not sufficient proof under the law of prior knowledge or use.)

We deny that testimony corroborating Gutzler (himself a party and consequently biased) as to what the blue prints represent is under the law sufficient.

Why, with the heavy burden of proof to a moral certainty upon defendants did not counsel point out where any witness had testified that such trap with such adjusting means was actually made or used?

Beginning near the top of page 38 appellants' opening brief, we discussed the nature of the evidence as to the alleged prior uses and explained fully the utter collapse of such evidence on rebuttal. It is important to notice that although our brief was served, as required by the rules, twenty days before the hearing, and although the defense of prior use was *vital to the*

defense, our version of the state of the record on this point has not been questioned.

Present day photographs (Appellees' Opening Brief, p. 30), still less than blue prints or drawings establish what was used prior to our date of invention. Why rely upon photographs when hundreds of Trumble traps were actually sold? As we have before remarked separation are not of a perishable nature. Scores of witnesses who actually used them could have been called as witnesses to prove the actual construction, mode of operation and use if they had actually been made and used.

Shall counsel's assertion (Appellees' Opening Brief, p. 31) that "evidence and proof was conclusive," that "it is established—demonstrated beyond peradventure of doubt—that defendants have been manufacturing Trumble gas traps of the type and construction and interrelation of parts and mode of operation illustrated in these working drawings"—be accepted in place of evidence that the actual traps were installed and used and made and operated in accordance with the blue prints (assuming for the moment and for the sake of arguments that any of the blue prints show the *complete* combination of our claims in suit.)

Remember that when defendants endeavored to *prove* such use they utterly failed as we have shown in appellants' opening brief, p. 39.

Again at the bottom of appellees' opening brief, p. 32, counsel, referring to the advertising cut of one of defendants' traps reproduced opposite page 5 of appel-

lants' opening brief, say: "This cut is not to scale and was for advertising purposes only and is shown not to be accurate." We deny the truth of this statement. Why did counsel attempt to substitute their own mere assertion. How easy it would have been to point out the *proof* if it existed.

What the court should expect from counsel for defendant-appellees are clear, responsive, pointed answers to the following questions: Was there actually a prior use? Where? By whom? Who says so? What is his interest in the controversy? How is he corroborated? What happened to his story on rebuttal? (As before stated, we answered this last question on page 38 appellants' opening brief, and counsel has not questioned the correctness of our answer.)

The fact that blue prints, drawings or even models illustrating the subject-matter of the claims in suit were made, is not defense to a Patent cause.

Walker on Patents (5th Ed.) Sec. 61, states the law (citing many cases in support of the text) as follows:

"Sec. 61. Novelty of a machine or manufacture, is not negated by any prior unpublished drawings, no matter how completely they may exhibit the patented invention (citing many cases), nor by any prior model, no matter how fully it may coincide with the thing covered by the patent. (Citing cases.)

"The reason of this rule is not stated by fullness in either of the cases which support it, but that reason is deducible from the statute and from the nature of drawings and of models. The

statute provides, relevant to the newness of patentable machines and manufactures, that they shall not have been previously known or used by others in this country. (Citing Revised Statutes, Section 4886.) Now, it is clear that to use a model or a drawing is not to use the machine or manufacture which it represents; and it is equally obvious that to know a drawing or a model is not the same thing as knowing the article which that drawing or model more or less imperfectly pictures to the eye. It follows that neither of those things can negative the newness required by the statute. Nor is the statutory provision on this point lacking in good reasons to support it. Private drawings may be mislaid or hidden, so as to preclude all probability of the public ever deriving any benefit therefrom; and even if they are seen by several or by many, they are apt to be understood by few or by none. Models also are liable to be secluded from view and to suffer change, and thus to fail of propagation. Moreover, if a patent could be defeated by producing a model or a drawing to correspond therewith, and by testifying that it was made at some sufficiently remote point of time in the past, a strong temptation would be offered to perjury. Several considerations of public policy and of private right combine, therefore, to justify the rule of this section.

“The word ‘model’ it should be noted as used in the foregoing connection is used in the limited sense of a ‘pattern, a copy, a representation usually upon a reduced scale’ and not in the sense of an operative structure identical with the structure of the patent.” (Citing *American Writing Machine Co. v. Wagner Typewriter Co.*, 151 F. R. 576, 1906.)

What Do We Assert to Be the Lorraine Invention
in Question?

Why, the Combination as a Combination of Each of
the Claims in Suit, of Course.

This Was Our Answer to the Same Question Dur-
ing the Trial (Near Bottom of R. 72, et seq.)

After we have definitely charged infringement of three specifically mentioned claims of the Lorraine Re-issue Patent, namely, claims 17, 18 and 19, what can be the purpose of counsel at middle of page 11 of appellees' opening brief in asking and emphasizing by italics, "*What is the asserted Lorraine invention which defendants are claimed to have infringed?*" Every one of the four eminent patent counsel who joined in this statement by signing appellees' opening brief, have actually prosecuted many applications for patents, and have no doubt drawn hundreds of patent claims. They all know, as they know their own names that the claims (Walker on Patents, 5th ed., Sec. 176) "are necessarily inserted to conform to the statutory requirement that the patentee shall distinctly point out and distinctly claim the part, improvement, or combination which he claims as his invention" (R. S. U. S. 4888); or as decided by the Supreme Court of the United States in, for instance, Continental Paper Bag Company v. Eastern Paper Bag Company, 210 U. S., 405, "the claims measure the invention." They also know that each claim of a patentee is treated as setting forth a complete and independent invention (Walker on Patents, 5th Ed., Sec. 177, p.

226, citing many cases); that the claim is the definition of the invention (Hopkins on Patents, p. 120), and is the definition agreed upon by the inventor and the Patent Office; and that (same reference) “the claim defines the metes and bounds of the inventor’s accomplishment;” or, in the words of Mr. Justice Bradley, in *White v. Dunbar*, 119 U. S. 47, the claim “is a statutory requirement for the purpose of making the patentee (applicant) define precisely what his invention is,” to which Judge Wallace in *Thomson-Houston Elec. Co. v. Elmira and H. Ry. Co.*, 71 Fed. Rep. 396, has added: “so distinctly and exactly as to apprise other inventors and the public what is withdrawn from general use.” Counsel is also familiar with the decision of this court in *Santa Clara Valley Mill and Lumber Company v. Prescott*, 102 Fed. Rep. 501, where Judge Gilbert speaking for the court said:

“The object of the claim in a patent is to publish to the world the precise nature of the invention the patentee seeks to protect.”

Counsel well knows that we cannot rely merely upon one of the incidents, features, or elements of the claim because there is no such thing in the law as infringement of an element or feature of a claim, as the omission in defendants’ device of a single one of the elements of the claim defeats a charge of infringement of that claim (*Hopkins on Patents*, p. 342, *et seq.*) and because each element of the claim or any sub-combination of elements mentioned in the claim less than the whole is presumed as a matter of law to be old (*Hopkins on Patents*, p. 214.)

Still less can we rely as a feature of novelty charged to be infringed on any feature, device, or element *not* part of the combination of the claims, because all elements, features, incidents, or devices or combinations described in the specification but not claimed are dedicated to the public, (Walker on Patents, (5th Ed.) Sec. 176, p. 221).

When, therefore, we are asked to specify the Lorraine invention which defendants are claimed to infringe, we can only reply "the combination as a combination of one or more or each of claims 17, 18 and 19 of the Lorraine Reissue Patent. If we should select a single element or incident or feature of the claim in place of the combination, such as the high oil level or more accurately the *means* for maintaining the high oil level, counsel will respond: "Why that is presumed as a matter of law to be old because you did not claim it separately but only in combination;" and if we specify a feature, device, element, or combination not mentioned in the claims, the reply will be, "that is dedicated to the public because you did not claim it."

With this elementary law (which is the very ground-work of their knowledge as patent attorneys), in mind, do not counsel come dangerously near trifling with the intelligence of court and opposing counsel, when, after we definitely specify the claims charged to be infringed, they solemnly charge us with (Appellees' Opening Brief, p. 12), evading a distinct and understandable answer to an inquiry as to what we claim

was the novel invention of Lorraine which has been “pirated” by defendants?

Most succinctly by way of summary: The Lorraine invention is the *combination* of elements mentioned in each of the claims in suit (each claim being in effect a patent by itself, Hopkins on Patents, pp. 119-121); that invention is not anticipated, because such combination *is not* found in any of the devices of the prior art; that invention is infringed by defendants because the combination of one or more or all of the claims in suit *is* found in defendants trap; that invention *is not* infringed by traps made in accordance with the Trumble patent because said combination is not found in said traps.

We Urge That Defendants Have Infringed Claims 17, 18, and 19 of the Patent in Suit, and Their Reply Is That They Have Not Infringed, for Instance, Claim 7 Calling, Among Other Things, for a Vertical Partition and Segmental Chambers, nor on Claim 3, and Others Which Are Limited Particularly to Valves.

A Defendant Is Charged With Burglarizing the House on the Corner, and His Defense Is That He Has Not Yet Robbed the Premises Next Door.

Beginning p. 13, appellees’ opening brief, after a quotation suggesting that our patent is worthless—notwithstanding that defendants admittedly *do* use the combination of the claims in suit—counsel proceeds to

explain and enlarge upon the things of the Lorraine patent which defendants *are not charged with infringing*, namely, the vertical partition, segmental chamber, specially constructed float, synchronously operated valves, etc. These things are protected by claims *not* in suit. We agree with counsel that they are valuable contributions to the art, and congratulate defendants in resisting temptation to appropriate them without our license (if such is the actual fact at the present time); but as long as we are not contending in this proceeding that defendants *have* infringed any of the claims covering them, why squander the time and attention of the court with their consideration. We can agree that counsel have neatly and effectively knocked down and demolished their man of straw, but after having done so why not consider those things which we believe the court will instantly recognize as the *real* issues, such as: Do the claims in suit describe defendants' device? Does defendants' device contain the combination of elements of any of the claims in suit? Does difference in form and location of an element of a combination defeat a charge of infringement? Shall the broad claims in suit be so limited that they are practically co-extensive with other narrow claims? Shall the claims in suit be construed as broadly as permitted by the state of the art? etc., etc. Those were questions which we deemed vital to the merits of the present appeal presented in appellants' opening brief, and the court will note in appellees' brief (ostensibly in answer thereto) that their consideration has been most largely ignored.

The Partition Separating the Chambers Is Not an Element of Any of the Claims in Suit, Any Comparison of Functions of the Vertical Partition With the Functions of the Trumble Cone Is Therefore Immaterial.

Regardless of Difference in Form and Location, the Receiving Chamber and Settling Chamber of Both Trumble and Lorraine Perform Functions in Common Vital to the Lorraine Combination in Suit, Namely, Those of Receiving the Oil and Preventing Agitation of the Contents of the Settling Chamber.

There is no real difference in the mode of operation between the receiving chamber of defendants' trap and that of the Lorraine Patent in suit. The chamber merely receives the oil in both cases. Even if it be said that the receiving chamber of Trumble, by reason of the arrangement of its partition, performs any additional function, this does not, under the law, as we have shown in our opening brief, defeat a charge of infringement.

There may be advantages in the use of the vertical partition and there may be other advantages in the use of a cone as a partition, but inasmuch as the *means* for the separation of the chambers *is not an element*, consideration or comparison of respective functions (still less form and location) is immaterial.

The Subject Matter of Our Claims Disclose a High Order of Invention.

So Little Reliance Did Counsel Place in the Plausibility of Any Attack Upon Invention of the Subject-Matter of Our Claims That, as We Have Shown in the Quotation of Counsel's Statement of the Issues Before the Trial Court (Appellants' Opening Brief, page 9, R. 87) Not Only Was No Defense of Non-Invention Suggested, But Counsel Tacitly Admitted Invention by Repeatedly Referring to the Subject-Matter as an "Invention" and as "Lorraine's Invention."

That the Subject-Matter Did Involve Invention Has Been Adjudicated by the Patent Office by the Very Grant of the Claims in Suit; and to This Presumption Has Been Added the Fact That Defendants, Although Engaged in Manufacturing and Selling Gas Traps for Years Prior to Lorraine's Advent Into the Field, Did Not Discover nor Utilize the Subject-Matter Until Shortly Before the Grant of the Original Lorraine Patent.

Conclusion.

The smoke screen of ink and confusion is a favorite cover of error in combating truth.

When issues can be fairly met it is not necessary to substitute for their discussion long statements of immaterial matters, such as concerning prior litigation between the parties to this suit, the number of the claims involved therein, etc.

If a defendant has a valid defense of non-infringement of claims in suit, he will invariably—especially when represented by such numerous and able counsel as those for appellees in the case at bar—not assert that he is unable to understand what invention he is charged with pirating; nor will he confusedly devote pages of argument to an attempt to show non-infringement of claims which he is *not* charged with infringing. He will recognize instantly that when plaintiff specifies claims 17, 18 and 19 as the claims relied upon and charged to be infringed that this means that claims 3, 7, and others are *not* charged to be infringed,—and he will not squander the attention of the court in discussing their subject-matter.

Knowing that only a single prior use will require a finding of invalidity of a patent in suit,—if such proof be in the record, he will not waste time rolling and unrolling numerous blue prints and handling present day photographs; he will not expect the court to rely upon his unsupported assertions;—he will point briefly, clearly, and distinctly, to *actual proof* of such single use, and will show how it is corroborated so that the court will not have to merely surmise that the subject-matter *may* be old, nor helplessly wonder whether or not it must read the entire record to find out, but will *know to a moral certainty* that the subject-matter is old. If there was a real defense we submit that counsel would have made it clear.

Respectfully submitted,

WESTALL AND WALLACE,
By JOSEPH F. WESTALL.